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IN THE SUPREME COURT OF THE UNITED STATES
October Term, 1972

No.

LOUIS ENDER, INC.,

Petitioner,

vs.

GENERAL FOODS CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

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The petitioner above-named, by SIDNEY S. BOBBE, its attorney, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit, entered on September 29, 1972, affirming the dismissal of the petitioner's complaint for failure to state a claim upon which relief could be granted.

THE OPINIONS BELOW

The opinion of the District Court has not yet been reported, but it appears in Appendix A *infra*.

The opinion of the Court of Appeals is reported at 467 F.2d 327, and it also appears in Appendix B infra.

JURISDICTION

The judgment of the Court of Appeals was dated and entered on September 29, 1972, and a rehearing was denied on October 19, 1972. The jurisdiction of this Court is conferred by 28 U.S.C. 1254 (1) and by 15 U.S.C. 1122 as amended.

THE QUESTIONS PRESENTED

1. Where a suit is brought in a state court, under state law, asserting that the plaintiff's registered trademark has been diluted by the defendant's use thereof; and where said mark had been registered by the plaintiff by means of false declarations to the Patent Office; is the defendant therein estopped from later recovering, pursuant to Sec. 38 of the Lanham Act, the damages caused by that suit merely because the complaint in the state court and that court in its decision had characterized the defendant's use of said registered trademark as an act of unfair competition?

2. Where a timely motion is made before the judge who tried a case, for a new trial on the ground of newly-discovered evidence, and where the judge dies before passing on the motion or signing the judgment, and where his successor refuses to hear the motion on the ground of lack of power, but signs the judgment; has the defeated party thereby been deprived of due process and the equal protection of the laws, and does the District Court have jurisdiction to entertain an action against the victorious party to have that judgment so entered declared a nullity?

THE STATUTES AND CONSTITUTIONAL PROVISION INVOLVED

The following sections of the Trademark Act of 1946, as amended, apply:-

"Sec. 37 (15 U.S.C. 1119). *Remedies – Power of Court over registrations*

In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon the records of the Patent Office, and shall be controlled thereby.

"Sec. 38 (15 U.S.C. 1120). *Remedies – Civil Liability for false or fraudulent registration*

Any person who shall procure registration in the Patent office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.

"Sec. 39 (15 U.S.C. 1121). *Remedies – Jurisdiction of courts*

The district and territorial courts of the United States shall have original jurisdiction, the circuit courts of appeal of the United States and the United States Court of Appeals for the District of Columbia shall have appellate jurisdiction, of all actions arising under this Act, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties."

"Sec. 40 (15 U.S.C. 1122) – *Remedies – Review by Supreme Court:*

"Writs of certiorari may be granted by the Supreme

Court of the United States for the review of cases arising under the Act in the same manner as provided for in cases of the patent laws."

Article 24 of the General Business Law of New York, entitled "Trade-Marks, Service Marks and Business Reputation" contains the following section:

"Section 368-d. *Injury to business reputation; dilution*

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services." (Book 19 McKinney's Consol. Laws of N.Y., p. 112)

Amendment XIV to the United States Constitution reads:

"*** No State shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States; nor shall any State deprive any person of life, liberty, or property, without due process of law, nor deny to any person within its jurisdiction the equal protection of the laws."

28 U.S.C. Section 1331 (a) reads:

"*Federal question, amount in controversy; costs.*

(a) The district courts shall have original jurisdiction of civil actions wherein the matter in controversy exceeds the sum or value of $10,000., exclusive of interest and costs, and arises under the constitution, laws, or treaties of the United States."

28 U.S.C. 1343(3) reads as follows: *"Civil Rights and Elective Franchises:*

District courts shall have original jurisdiction, of any civil action authorized by law to be commenced by any person ** (3) to redress *** the deprivation, under color

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of any state law, statute, ordinance, regulation, custom or usage, of any right, privilege or immunity secured by the Constitution of the United States, or by any act of Congress providing for equal rights of citizens or of persons within the jurisdiction of the United States."

Rules 4404(b), 4405, 5015(a)(2) and 9002 of the *New York Civil Practice Laws and Rules* are set forth in Appendix D *infra*

STATEMENT OF THE CASE

a. The cause of action under the Lanham Act.

The Court of Appeals dismissed the complaint for failure to state a claim upon which relief could be granted. (B8) The first cause of action is one brought under Sec. 38 of the Lanham Act (15 U.S.C. § 1120), which creates a civil liability of

> "any person who shall procure registration in the Patent Office of a mark by a false or fraudulent declaration or representation"

to

> "any person injured thereby, for any damages sustained in consequence thereof."

The amended complaint (Appendix C *infra*) alleges that petitioner (hereinafter "Ender") was the owner by assignment of the trademark "Maxim" for sardines, registered in 1908 in Class 46, *Foods and Ingredients of Foods*, which registration is in full force and effect; and that as such owner, it gave consent to the use by respondent (hereinafter "General Foods") of the "Maxim" mark, limited, however, to coffee and tea in any form. (C1-C2)

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The complaint then proceeded to allege the following:-

On January 21, 1964, General Foods, without revealing the fact that it had obtained such limited consent, filed an application with the Patent Office for registration of the same mark, "Maxim", for coffee, and, in order to procure the registration, it made several false statements in said application, to wit: (1) that the mark had first been used by it in interstate commerce on November 29, 1963; (2) that at the time of the application the mark was in use by it in such commerce; (3) that it believed itself to be the true owner of the trademark "Maxim"; and (4) that to the best of its knowledge and belief, no-one else had the right to use the mark in commerce, either in identical form or in such near resemblance thereto as would be likely, when applied to the goods of such other person, to cause confusion or to cause mistake or to deceive (Pars. "EIGHTH" to "TWELFTH", C3-C4).

On September 1, 1964, the Patent Office granted to General Foods the registration of the trademark it had thus applied for. (C4)

In May, 1967, General Foods commenced an action against Ender in the Supreme Court of the State of New York, claiming that it was the owner of the trademark thus procured by it, and that Ender's use thereof on food products such as fruit and vegetable juices constituted, according to Section 368-d of the New York General Business Law* an unlawful and unfair trade practice, likely to "dilute the use of the name and the distinctive quality of the trademark thus registered by it", [General Foods], and that such "dilution of the trademark constituted grounds for injunctive relief in cases of infringement of a trademark." (Par. "THIRTEENTH" C4)

*Part of article 24, which provides for state registration of trademarks.

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After trial, a permanent injunction was granted, the court finding that Ender's *use of the registered trademark* on fruit juices and tomato juice was an *unfair trade practice*, in violation of Section 368-d of the New York General Business Law, and that such use was *likely to dilute the distinctive quality of General Foods' registered trademark* (C-5).

The amended complaint then alleges that Ender had been damaged, by being put to great expense in the defense of the aforesaid action, and in an unsuccessful appeal, including payment of attorney's fees and expenses and of costs in excess of $9,000.; also by having to dispose of large quantities of juices at a sacrifice, and by being prevented from making any further sales thereof (C7-C8); and finally that such damage had been caused by General Foods' dependance in the suit on said falsely or fraudulently-procured registration. (C8)

Instead of answering, General Foods moved for summary judgment, or, in the alternative, for dismissal of the complaint, on the ground that it failed to state a claim upon which relief could be granted. (A1) The motion for summary judgment was granted by the District Court, on the sole ground that the findings of the state court collaterally estopped Ender from proving that the registration by General Foods was procured by fraud. (A4-A5)

The Second Circuit, however, rejected that claim of collateral estoppel, saying (B8) that

> "the district court's grant of General Foods' motion for summary judgment on the ground of collateral estoppel was erroneous."

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Nevertheless it affirmed the *dismissal of the complaint*, for a different reason, viz., a "failure to state a claim upon which relief could be granted." According to its opinion,

> "even assuming that General Foods procured registration of the trademark on the basis of false declarations in its application, Ender failed to allege 'any damages sustained in consequence thereof.' " (B2)

In so saying, the court disregarded the allegations of damages attributable to the state suit, which are specified in the amended complaint (C7-C8). Instead, it concluded from a reading of the *decision of the state court*, that the state suit was not dependent on the registration of the trademark by General Foods, but that General Foods "prevailed on the merits on a theory of *unfair competition*" (B8); also that the state court's opinion demonstrates that the "decision in favor of General Foods was based on the theory that *Ender's conduct in labeling the canned juices with the name 'Maxim' constituted unfair competition*" (B6). Therefore, it concluded that "Ender has failed to allege any damages "sustained in consequence" of the alleged false declarations in the application for registration." (B8)

This conclusion was reached because the state court had said:

> "As to the second cause of action for unfair trade practices, Section 368-d of the General Business Law [of New York] explicitly provides that the remedies of the section are available to protect a trademark 'registered or not registered.' The irrelevance of the assertion of fraudulent conduct with respect to plaintiff's application for registration is, in our opinion, dispositive of defendant's contention, so far as the issues presented in this action are concerned." (B7)

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While it is true that the New York statute made its remedies available to *either* a registered or an unregistered trademark, the record shows, as alleged in the amended complaint, that the state suit was based *exclusively* on Ender's use of the *registered* trademark. No "unregistered trademark" was pleaded or proved, or found by the state court.

Thus, that decision, despite the ambiguous portion quoted above as to the mere *possibility* of suing on an unregistered trademark, had expressly held that it was the use by Ender of the *registered* trademark on fruit juices and tomato juice which "constituted an unfair trade practice" because General Foods had established "the likelihood of *** dilution of the distinctive quality of [General Foods'] use of *its registered trademark* for coffee" (C5-C6)

There was no allegation, no proof and no finding in the state court of any act of "palming off" or deception of the public, and therefore there was no basis for the statement by the Second Circuit that General Foods had prevailed in the state court "on the merits on a theory of unfair competition", or that that action was "not predicated upon the federal registration." (B8)

The state court's statements quoted above, that the registration by General Foods was irrelevant, is thus irreconcilable with the same court's final determination that the "unfair trade practice" consisted of Ender's "dilution" of the "distinctive quality" of General Foods' "*registered* trademark."

In his opinion below Judge Hays stated that Ender's trademark "Maxim" was used "only in connection with sardines prior to 1965" (B2). This is directly contrary to the fact, and

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is certainly nowhere to be found in the state court's decision. Indeed, as the Record below shows, there were in evidence on the trial many catalogs published in the fall of 1956 and subsequently, listing a great many canned food products other than sardines sold under the name "Maxim", *including tomato juice and four different kinds of fruit juices*, by Ender and its predecessors.

As the owner of the "Maxim" trademark registered for sardines in Class 46, Foods and Ingredients of Foods, Ender had the right to apply it, as Ender and its predecessors had done, to other food products, and to prevent others from doing so, under the well-established doctrine of expansion of business (*L. A. Waterman Co. v. Gorda*, 92 F. 2d 272, 2d Cer. 1934; *Continental Motors v. Continental Aviation Corp.*, 395 F. 2d 857, 861; C.A. 5, 1967; 1 Seidel-Dubroff, *Trademark Law and Practice*, 1963, p. 737).

The Court of Appeals may have been unconsciously influenced by this misapprehension as to the facts.

To estop Enter from proving its damages on the ground that the state court's decision was based on a "theory of unfair competition" and that "labeling the canned juices with the name 'Maxim' constituted unfair competition", when in fact it was based solely on the fraudulently registered trade mark, runs directly counter to the holdings of this Court:

Sears, Roebuck & Co. vs. Stiffel Co., 376 U.S. 225 (1964);

Compco Corp. vs. Day-Brite Lighting Co., 376 U.S. 234 (1964).

> "The question is whether a state's unfair competition law, can, consistently with federal patent laws, impose liability

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for or prohibit the copying of an article which is protected by neither a federal patent nor a copyright."

There, Stiffel had obtained a design patent on a lamp, and Sears copied the lamp. Stiffel then brought suit claiming infringement, and in a separate claim alleged that the sale of Sears' lamp caused confusion in the trade as to the source of the lamps, and that thereby Sears engaged in "unfair competition", as defined by the Illinois courts. The district court held the design patent invalid, but also held that because the lamps were so much alike as to cause confusion, therefore Sears was guilty of unfair competition. The United States Court of Appeals affirmed, holding that to make out a case of unfair competition under Illinois law, it was necessary to show, not that Sears had been "palming off", but only the likelihood of confusion as to the source of the product – precisely the claim made here.

This court reversed, Mr. Justice Black saying at p. 229, (after pointing out that the patent laws are the supreme law of the land):

> "When the state law touches upon the area of these federal statutes it is 'familiar doctrine' that the federal policy 'may not be set at naught, or its benefits denied' by the state law. This is true even if the state law is enacted in the exercise of otherwise undoubted state power."

And at p. 231:

> "Just as a state cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws."

Even as the patent laws are the supreme law of the land, so is the trademark act, enacted as it was in the regulation of

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interstate commerce. To allow General Foods to restrain the use by another, (much less the valid owner of the same mark), of a trademark it has registered by fraud – in effect no trademark at all – under a claim of unfair competition, would be "to set at naught" the salutary provisions of the trademark act; indeed the very sanction provided by the act. Not only would the federal policy of the statute be thus set aside, but Ender would be deprived of the remedy of Section 38 of the Lanham Act, only because of the characterization by the state court that Ender's use of the falsely registered mark is an "unfair trade practice."

The *Compco* case, *supra*, decided the same day as *Sears*, is to the same effect. There, there was copying of an article whose patent was invalid, and this Court said, what is applicable here (at 376 U.S. 236):

> "There was no testimony given by a purchaser or by anyone else that any customer had ever been misled, deceived or 'confused', that is, that anyone had ever bought a Compco fixture thinking it was a Day-Brite fixture."

Indeed, a different panel of the Second Circuit followed *Sears, Roebuck* in a case where a greeting-card manufacturer sought to enjoin a former employee from selling greeting cards that were similar in format and manner of display to plaintiff's. The court held that in the absence of patent or copyright or of intentional passing-off there was no right to an injunction.

Riback Enterprises v. Denham, 452 F2d 845 (1971).

The Sixth Circuit held to the same effect in a case where it was claimed that the interference with a contractual right was unfair competition.

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Cable Vision v. KUTV Inc., 385 F.2nd 348 (1964).

In *G. Ricordi vs. Haendler*, 194 F 2d 914 (2d Cir. 1952), the same principle had been applied where the plaintiff possessed an *expired copyright* on the opera *Falstaff*. The defendant had reproduced the printed libretto and score, and the plaintiff claimed that this was unfair competition because the typography was its property and was not dedicated to the public. Judge Learned Hand, in dismissing the complaint, said at p. 915:

> "However, even though state law held that publication was not a dedication, we should feel bound to disregard it, because the question would still be, not one of state law, but of federal law."

That principle was also applied by the New York Court of Appeals in *Hebrew Publishing Co. vs. Scharfstein*, 288 N.Y. 374, 376 (1942). There, the plaintiff, holding *no copyright*, sought to restrain the offset copying of its text and its Hebrew plates, on the ground of unfair competition. The Court of Appeals held that the plaintiff could not recover, and that there was no unfair competition, in the absence of a finding of "fraud, breach of trust or imposture of the defendant."

In *Estate of Hemingway v. Random House*, 23 N.Y.2d 341 (1968), the plaintiffs asserted a claim of common-law copyright (which the court held could not be established), and in a second count charged that the same facts established a case of unfair competition. As to the latter count the court said, per Fuld, Chief Judge, at 23 N.Y. 2d 350:

> "The second count does no more than put another label on the same allegations as those upon which the first was

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based. As Justice Schweitzer expressed the thought at Special Term, '[t]he reasoning which denied [the plaintiffs] protection or recovery on theories of common-law copyright also operate to deny recovery on any theory of unfair competition' (53 Misc. 2d 462, 472) ***"

In *Sola Electric Co. v. Jefferson Co.*, 317 U.S. 173, 176 (1942), this Court held that state laws creating an estoppel "will not be permitted to thwart the purposes of statutes of the United States" – in that case the patent laws.

In *Lear, Inc. vs. Adkins*, 395 U.S. 653 (1968), a licensee of a patent was held free to question the validity of that patent, this Court saying at pp. 669-670, what is likewise a *propos* here:

> "Consider, for example, the equities of the licensor who has obtained his patent through a fraud on the patent office. It is difficult to perceive why good faith requires that courts should permit him to recover royalties despite his licensee's attempts to show that the patent is invalid."

In *Precision Instruments v. Automotive Maintenance*, 321 U.S. 806 (1945) this Court said at 321 U.S. 816:

> "The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct, and that such monopolies are kept within their legitimate scope."

What was there said regarding the public interest in patents applies as well to the public interest in seeing that trademarks are free from fraud.

There is no distinction in principle between the above-cited cases involving patents and copyrights, and the instant

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case, involving a trademark. To affix the label of "unfair competition" in the absence of any proof of "palming off" or deception, to a suit based on an illegally-registered trademark (in law no trademark at all) does not change the nature of the suit. The rose remains a rose, by whatever name it happens to be called. Ender was damaged by the state suit based on the fraudulently registered trademark, even though that suit was labeled as one to prevent unfair competition; and it was therefore error to dismiss the complaint.

b. The Constitutional Question

By the second cause of action in the district court (C8) Ender sought to obtain a judgment declaring that the state court's judgment is null and void, having been procured in violation of due process and of the equal protection of the laws, as guaranteed by the Fourteenth Amendment, because the state court refused arbitrarily to hear a motion made by Ender for a new trial on the ground of newly-discovered evidence. It was there alleged that such a motion had been timely made before the trial judge, on substantial grounds, but that the trial judge had died without deciding it, that the motion was promptly renewed before his successor, the administrative judge, who refused to hear it or pass on its merits, on the ground that he had no power to do so. At the same time, however, he signed the judgment carrying out the decision of the trial judge. (C9-C10)

On appeal, both order and judgment were affirmed, without opinion; and a motion for leave to appeal to the New York Court of Appeals was denied.

Under the New York Civil Practice Act (Appendix D) a

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defeated party in a non-jury case is accorded the right to move for a new trial within fifteen days after the decision, on the ground of newly-discovered evidence; which motion must be made before the trial judge. However, if the new evidence could not have been discovered within that time, it could then be made "before the court" (D-1).

The successor judge held that since the new evidence had been discovered within fifteen days, and the motion had then been made, only the trial judge, and not "the court" had the power to hear the motion; and he therefore refused to pass on the merits (C9–C10). So construed, the statute makes an invidious discrimination between litigants, without rational basis, in denying to Ender a remedy belonging to suitors generally, thus constituting a denial of the equal protection of the laws, and of due process.

This Court has held that where a trial judge dies before passing on such a motion, his successor must pass upon it.

Life and Fire Insurance Company v. Wilson's Heirs, 33 U.S. 291 (1834).

In that case a trial judge died before signing a judgment based on his decision. Until a judgment was signed, the judge had the power to grant a new trial. His successor refused to sign the judgment, claiming lack of power because the motion for a new trial had not been and could no longer be passed upon by the trial judge. This Court granted an absolute writ of mandamus, ordering the successor to proceed; saying at p. 303:

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"But the District Judge is mistaken in supposing that no one but the judge who renders the judgment can grant a new trial. But, as the successor of his predecessor, he can exercise the same powers, and has a right to act on every case that remains undecided upon the docket, as fully as his predecessor could have done. *The court remains the same, and the change of the incumbent cannot and ought not, in any respect, to injure the rights of litigant parties.*" (Emphasis supplied)

In *Cahill vs. Mayflower Bus Lines,* 77 F. 2d 838 (2d Cir. 1935); cert. den. 296 U.S. 629, the parties had stipulated that the trial judge could pass upon a motion for a directed verdict after the rendition of the jury's verdict. Before he could do so, he died. Held, that the reservation applied to the court, and that the successor judge was required to pass on it.

In *People vs. Rao,* 271 N.Y. 98 (1936), the defendants were convicted of a crime, and their counsel was permitted to move for a new trial on the day of sentencing, but before that day arrived the trial judge died. Held, that his successor was entitled to pass upon the motion.

In *Benson vs. Hall,* 197 Mass. 517 (1908), while a motion for a new trial was under advisement before the trial justice, he died (just as here). The Chief Justice then decided the motion, notwithstanding the defendant's contention that only the trial justice had that power. It was held that it was the court, and not a particular judge, that had the power to decide "all matters which remain undecided in the case."

To the same effect: *Commonwealth vs. Gedzium,* 261 Mass. 299 (1927); *State vs. Messino,* 325 No. 742 (1930); *St. Louis, S.W. Rly. vs. Henwood,* 159 F. 2d 337, 342 (8th Cir., 1946); and *People ex rel. Hambell vs. McConnell,* 155 Ill. 192 (1895).

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There was thus no logical, legal or rational basis for the discriminatory treatment of Ender by the successor judge, in refusing to hear the motion for a new trial because the trial justice had died, while at the same time signing the judgment in place of the trial judge.

The affirmance of the order by the Appellate Division merely upheld the determination that the successor judge lacked the *power* to hear the motion on its merits; yet the merits could only be passed upon by him.

As this Court said in *Life and Fire Ins. Co., supra*, at 33 U.S. 304:

> "••• a superior court will never direct in what manner the discretion of an inferior tribunal shall be exercised; but they will, in a proper case, *require the inferior court to decide*." (Emphasis supplied)

Here, the appellate court did not "require the inferior court to decide", but upheld its *refusal* to decide – an arbitrary denial of due process and of equal protection of the laws.

In *Boddie vs. Connecticut*, 401 U.S. 371 (1971), this Court said at p. 374, per the late Justice Harlan:

> "At its core the right to due process reflects a fundamental value in our American Constitutional system."

And at p. 377:

> "••• Due process requires, at a minimum, that, absent a countervailing state interest of over-riding significance, persons forced to settle their claims of right and duty through the judicial process must be given a meaningful

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opportunity to be heard."

And again, at p. 379:

> "Our cases further establish that a statute or rule may be held Constitutionally invalid if applied where it operates to deprive an individual of a protected right, although its general validity as a measure enacted in the legitimate exercise of state power is beyond question."

In a concurring opinion, Mr. Justice Brennan said at page 387:

> "The right to be heard in some way at some time extends to all proceedings entertained by courts."

To the same effect:

Yick Wo vs. Hopkins, 118 U.S. 356, 373-374; (1885);
Armstrong vs. Manzo, 380 U.S. 545; (1954)
Goldberg vs. Kelly, 397 U.S. 254, 269 (1970);
Holmes vs. New York City Housing Authority, 398 F. 2d 262, 265 (C.A. 2d, 1968);
Grannis vs. Ordean, 234 U.S. 385, 394 (1914).

THE DISTRICT COURT HAD JURISDICTION

The Court of Appeals held that "the district court should have dismissed for failure to state a claim upon which relief could be granted" (B8). But, inconsistently it also held that "Ender's attempt to assert the constitutional claim suffers from fatal defects," the first of which was that General Foods could not be considered the proper defendant in an action brought under 28 U.S.C. §§ 1331(a), 1343(3), as this one was, "since Ender does not argue that *General Foods'* conduct 'damaged' Ender or deprived it of any federal rights under color of state law." (B9)

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It is submitted, however, that this complaint *does* sufficiently show proper jurisdiction under 28 U.S.C. § 1331(a), because it adequately alleges that a federal question arises under the Fourteenth Amendment, because Ender was deprived of due process and equal protection and that the jurisdictional amount in excess of $10,000 exists. (C11)

In *Bell v. Hood*, 329 U.S. 678, 684 (1946), this court held that "where federally protected rights have been invaded, it has been the rule from the beginning that courts will be alert to adjust their remedies so as to grant the necessary relief."

To the same effect: *Bivens v. Six Unknown Narcotic Agents* 403 U.S. 388 (1971). In the *Bell* case it was held that in deciding jurisdiction the district court must look to the way the complaint is drawn so as to assert a right of recovery under the Constitution. This complaint meets that test, and since it seeks a declaratory judgment to the effect that General Foods' state judgment is null and void, the federal suit was properly brought against it.

Jurisdiction under 28 U.S.C. § 1343(3) also existed in the District Court, for Ender *does* argue that the action of General Foods in opposing the motion for a new trial, and in obtaining its judgment despite that motion, *did* deprive Ender of its constitutional rights "under color of state law".

Zwickler vs. Koota, 389 U.S. 241, 245 (1967).

As a second ground for denying jurisdiction, Judge Hays stated, (B10) incorrectly, that the attack on the judgment was made by Ender only in order to deny its use as a collateral estoppel (a false assumption) and that since the court was

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denying estoppel on the question of the falsity of the registration, the argument was no longer material. To say this, is to overlook the fact that while the court was denying estoppel to the judgment on the question of *falsity*, it was at the same time *granting* estoppel to the judgment on the question of whether Ender could claim that it was *damaged* by such falsity. Thus, it held that Ender could not claim such damage, only because of what the *decision of the state court* supposedly showed.

If, however, as Ender claims, the judgment was procured in disregard of the requirements of due process, it would have to be denied validity as such an estoppel in subsequent litigation.

Postal Telegraph Cable Co. vs. City of Newport, Ky., 247 U.S. 464, 476 (1918).

And the amended complaint did seek a declaration that it was void for all purposes (C9).

Judge Hays also set forth (B10) a third ground which he considered the "most important" – that the issue of constitutionality was

> "part of the entire case presented to the Appellate Division and was also presented to the Court of Appeals *** The proper procedure for Ender to follow in order to vindicate what it asserts to be its constitutional right was to appeal the decisions of the state courts to the Supreme Court."

He admitted that the record does not "clearly disclose" that the issue *was* presented to the Appellate Division; (and it never was). The fact that it was presented to the Court of Appeals on the motion for leave to appeal, which was denied,

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does not constitute litigation of the issue, for it is well established that denial of such a motion merely indicates a discretionary refusal to hear the appeal.

Marchant vs. Meade-Morrison Mfg. Co., 252 N.Y. 284, 297-298, per Cardozo, C.J.

In view of the fact that the constitutional issue was not litigated in the state court, it was properly presented in the district court.

England vs. Louisiana Board of Medical Examiners, 375 U.S. 411 (1963).

Zwickler vs. Koota, 389 U.S. 241, 245 et seq. (1967).

And by the same token, since it was not presented in the state court, a direct review could not have been heard in this Court.

Carlisle vs. Louisiana, 394 U.S. 437 (1969).

In concurring in the dismissal of the complaint, Judge Oakes said that he did not believe that a corporation was a "person" entitled to enforce 28 U.S.C. § § 1331 and 1343(3). In so stating, he undoubtedly overlooked the decisions of this Court to the contrary, which expressly hold that

> "a corporation is a 'person' within the meaning of the equal protection and due process clauses"
>
> *Grosjean vs. American Press Co.,* 297 U.S. 233, 244 (1936);
> *Covington & Lexington Turnpike Co. vs. Sanford,* 164 U.S. 578, 592-593. (1896)

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It is therefore clear that the constitutional question was properly raised; that the district court had jurisdiction; and that the refusal by the state court to grant Ender a hearing on its motion for a new trial was a denial of due process and of the equal protection of the laws.

REASONS FOR GRANTING THE WRIT

I

An important question of trademark law is involved, which has been decided in a manner in conflict with applicable decisions of this Court, as exemplified by *Sears, Roebuck & Co. vs. Stiffel Co.*, 376 U.S. 225, *supra*. Thus, the Second Circuit has held here, that although a state suit was brought to restrain the alleged dilution of a Federally registered trademark, admittedly obtained by false declarations, that suit was actually predicated, not on the existence of said trademark, but on the theory that the alleged dilution of that trademark, without any claim of "palming off" or fraud, constituted unfair trade practice. Such a holding is obviously directly contrary to the principle of *Sears, Roebuck*, wherein this Court held that a state law cannot be used to restrain the copying of an article the patent on which is held to be invalid, even though the state law describes such copying as unfair competition.

The principle of *Sears, Roebuck* has been applied in other courts in litigation cited above, some of which involved expired copyrights or alleged common-law copyrights; and there is no valid reason why that principle should not be applied to a trademark which is invalid because registered by fraud.

If the decision below is allowed to stand, then the

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provisions of the Federal Trademark Law, requiring truthful declarations in the registration of a trademark, are stripped of all efficacy, for then a party obtaining registration by fraud can nevertheless, by the mere device of using a state law, obtain all the benefits of a lawful registration, and can sidestep the penalties of his false registration by describing his action as one brought simply to restrain unfair trade competition.

II

An important question of constitutional law is also presented, namely, whether it is due process to refuse to hear a litigant seeking to present newly-discovered evidence after trial, but before judgment, which evidence if accepted would change the indicated result, for the sole reason that the trial judge has died while such motion for a new trial was pending before him. The holding here by the successor judge that he did not have the power to hear the motion is in conflict with the holding of this Court in *Life & Fire Insurance Co.*, 33 U.S. 291, decided as far back as 1834, as well as with what other courts have universally held since then. Newly-discovered evidence has all the attributes of evidence offered at the trial itself. Not only to exclude it, but to deny the defeated party the right to be heard, because of a supposed gap in the New York statute, is a denial of due process and of the equal protection of the laws. The state courts could have bridged any gap in the statute, by the exercise of their inherent powers over their proceedings, in order to grant due process, instead of denying Ender a hearing. Such a constitutional right should not be foreclosed by the death of the trial judge, while a timely motion was pending before him. Otherwise the law becomes but a mere game of chance.

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The Court of Appeals did not pass on the merits of the constitutional claim, but ruled that the District Court lacked jurisdiction. It is urged that such a ruling is at odds with the above-cited decisions of this court which hold that a complaint such as this, presents a federal question, within the meaning of 28 U.S.C. § 1331(a), and of 28 U.S.C. § 1343(3).

Zwickler vs. Koota, 389 U.S. 241, 245 (1967).

In addition the holding that the Constitutional question could not be urged in the District Court only because it had been unsuccessfully raised on a motion for leave to appeal to the New York Court of Appeals, is in direct conflict with the *Zwickler* case *supra* and also with *England vs. Louisiana Board of Medical Examiners,* 375 U.S. 411, (1963).

CONCLUSION

For the foregoing reasons it is respectfully submitted that the petition for certiorari should be granted.

Dated: New York, December 11, 1972.

Respectfully submitted,

SIDNEY S. BOBBE
Attorney for Petitioner,
36 West 44th Street
New York, N.Y. 10036

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APPENDIX A

OPINION OF PALMIERI, U.S.D.J.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

LOUIS ENDER, INC.,

Plaintiff,

-against-

GENERAL FOODS CORPORATION,

Defendant.

PALMIERI, J.

Defendant moves for summary judgment on the ground that prior determinations by New York courts in this action between the same parties are *res judicata* as to issues which are dispositive of this action. Rule 56, Fed. R. Civ. P. The motion is also based upon alternative grounds under Rule 12(b) (1) and 12(b) (6), Fed. R. Civ. P., but these need not be discussed in view of the conclusions hereinafter set forth.

This controversy presents a conflict with respect to the use of the trademark MAXIM. Plaintiff Louis Ender, Inc. (Ender), which owned the registered trademark MAXIM for sardines, entered into an agreement dated July 31, 1963, whereby Ender

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granted to General Foods' assignor "his nominees and/or assigns its consent to the registration and/or use of the name MAXIM limited to coffee in any form and tea in any form." Ender further agreed that it would "not use the name MAXIM for any coffee, coffee product, beverage product, or any preparation for use in making any beverage or beverage product."

General Foods began to market coffee under the MAXIM mark in November 1963. In January 1964 it filed its application to register the mark for that purpose, relying upon its use of the mark on coffee and the absence of any use by others of the MAXIM mark for that product. In September 1964 General Foods was granted registration. Some time thereafter Ender began to sell orange juice and other beverages under the name MAXIM. In 1967 General Foods initiated litigation in the New York Supreme Court, Westchester County, for a permanent injunction to restrain Ender from marketing beverages under the MAXIM mark, claiming that Ender had breached the consent agreement and had engaged in unfair competition. In July 1970, while that litigation was *sub judica*, Ender filed a complaint in this court alleging that General Foods fraudulently obtained registration of the MAXIM trademark for coffee and sought cancellation of the federal registration (*Louis Ender, Inc. v. General Foods Corporation*, 70 Civ. 3050).

In an opinion dated February 10, 1971, this court stayed all proceedings before it to abide the decision of the New York State Supreme Court. On May 28, 1971, a final judgment was entered in the Supreme Court, Westchester County, granting General Foods a permanent injunction restraining Ender from marketing beverages under the MAXIM name (*General Foods Corporation v. Louis Ender, Inc.*, Index No. 12182/68). That decision was unanimously affirmed by the Appellate Division,

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Second Department, on November 1, 1971. Thereafter the New York Court of Appeals denied leave to Ender to appeal by order of December 1, 1971, and denied Ender's motion to reargue its motion for leave to appeal by order of January 7, 1971. On this date Ender filed an amended complaint in this court. What follows assumes a familiarity with this court's opinion of February 10, 1971, and with the New York State court proceedings.

Ender's amended complaint before this court again alleges that General Foods fraudulently obtained registration of the MAXIM mark thereby resulting in damages to Ender in that the latter was obligated to litigate the action General Foods brought against Ender in New York and that the consequent injunction "forced" Ender to dispose of large quantities of canned beverages "at a great sacrifice." An additional allegation is in the nature of a civil rights claim that because the trial judge had died before passing on Ender's application for a new trial, Ender was therefore denied due process of law and was deprived of equal protection of the laws.

For reasons that appear below this court grants General Foods' motion for summary judgment to dismiss Ender's amended complaint in this court.

Ender's claim of fraudulent conduct of General Foods relating to its application for registration of the trademark MAXIM for coffee is without merit. The New York trial court expressly found that General Foods' claim of ownership of the name MAXIM was a claim of ownership of that name for use in marketing coffee and was not an assertion of general ownership and that General Foods could and did properly state in its application that it knew of no right to use that name which

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would conflict with its use for coffee. The trial court expressly concluded that Ender's "claim of fraudulent conduct of [General Foods] in connection with its filing of its application for registration of the trademark MAXIM for coffee is without merit." That court's final judgment of May 28, 1971, ultimately affirmed by the New York Court of Appeals, and subject to no further appeal, is therefore conclusive between the parties. The issues upon which Ender's claim is asserted here were finally and conclusively determined adversely to Ender. The doctrine of collateral estoppel thus prevents Ender from relitigating these issues here. See *Vernitron Corporation v. Benjamin*, 440 F. 2d 105, 108 (2d Cir. 1971); *Zdanok v. Glidden Company, Durkee Famous Foods Division*, 327 F.2d 944, 953 (2d Cir. 1964).

Ender's remaining grievances are without substance. Ender's litigation expenses in defending the action properly brought against it by General Foods and its compliance with the court's decision "at a great sacrifice" can hardly be deemed to be more than the risks incurred by any unsuccessful litigant. Ender cannot claim compensable damage because it lost a meritorious action brought against it. Ender's claim of the denial of its constitutional rights is based upon an alleged grievance thoroughly litigated before the New York State courts – that it was entitled to a new trial after the tragic death of Justice Galloway notwithstanding the conclusion of the trial and the filing of a detailed decision granting General Foods permanent injunctive relief. A separate appeal was taken by Ender from the denial of its motion for a new trial and the Appellate Division, after a full hearing, unanimously affirmed the order denying Ender's motion.

Traditional principles of comity, *res judicata* andpublic policy affecting federal-state relationships strongly militate

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against any review of the resolution of this controversy by the New York State courts after some four years of litigation. *Restatement of Judgments*, Chap. 3 § 68(1)(1942), Wright, *Law of Federal Courts*, pp. 171 et seq. (1970 ed.); Note, *Federal Jurisdiction and Res Judicata: Litigation in State Courts of Federal Constitutional Questions Closing the Door to the Federal Courts*, 24 U. Miami L. Rev. 835 (1970). Nor are any discernible constitutional questions posed by this contention.

The motion of General Foods for summary judgment dismissing Ender's complaint is granted. It is so ordered.

Dated: New York, N.Y.
February 4, 1972

s/ Edmund L. Palmieri
EDMUND L. PALMIERI
U. S. D. J.

APPENDIX B

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 770—September Term, 1971.

(Argued June 12, 1972 Decided September 29, 1972.)

Docket No. 72-1271

LOUIS ENDER, INC.,

Appellant,

v.

GENERAL FOODS CORPORATION,

Appellee.

Before:

KAUFMAN, HAYS and OAKES,

Circuit Judges.

Appeal from an order of the United States District Court for the Southern District of New York, Edmund L. Palmieri, *Judge,* granting summary judgment to defendant in an action for damages for procuring federal registration of a trademark as a result of false declarations in an application for registration, 15 U.S.C. §1120 (1970).

Affirmed.

SIDNEY S. BOBBE, New York, New York, *for Appellant.*

ROBERT MACCRATE, New York, New York (William T. Stephens, Sullivan & Cromwell, New York, New York, on the brief), *for Appellee.*

HAYS, *Circuit Judge:*

Louis Ender, Inc. appeals from an order of the United States District Court for the Southern District of New York granting defendant-appellee General Foods Corporation summary judgment in an action under 15 U.S.C. §1120 (1970) for "damages sustained in consequence" of appellee's alleged procurement of federal registration of the trademark "Maxim" by false declarations in its application for registration. The district court ruled that Ender was collaterally estopped from relitigating issues that had been "finally and conclusively determined adversely to Ender" in a prior action in the Supreme Court of New York. We affirm on the ground that, even assuming that General Foods procured registration of the trademark on the basis of false declarations in its application, Ender failed to allege "any damages sustained in consequence thereof."

I.

Louis Ender, Inc., a wholesale grocery business located in New York, is the assignee of the trademark "Maxim," first registered with the Patent Office in 1908. That trademark was registered specifically for use in the sale of sardines, and, prior to 1965, the trademark was used by the successive assignees only in connection with sardines. General Foods Corporation produces and distributes a large variety of food products, including instant coffee. While continuing to produce and to sell regular instant coffee under its "Maxwell House" label, General Foods developed a process for "freeze drying" coffee. When General Foods considered marketing the new form of instant coffee, it decided that the name "Maxim" would be suitable, perhaps because it was suggestive of General Foods' "Maxwell House" brand of regular instant coffee. General Foods discovered that that mark was not registered for

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coffee but that appellant was the assignee of that mark for sardines. To avoid the possibility of friction, Alexander A. Forgacs, an agent of General Foods, procured a consent agreement from Ender on July 31, 1963. This agreement was subsequently assigned to General Foods by Forgacs. Under this agreement:

> "(1) Ender . . . [granted] its consent to the registration and/or use of the name MAXIM limited to coffee in any form and tea in any form and . . . [acknowledged] its belief that such use of the name MAXIM is not likely to cause confusion or deception of purchasers.
>
> "(2) Ender [agreed] not [to] use the name MAXIM for any coffee, coffee product, beverage, beverage product, or any preparation for use in making any beverage or beverage product."

On November 29, 1963 General Foods began test marketing the freeze-dried coffee under the name "Maxim." On January 21, 1964 it filed an application with the Patent Office for registration of the trademark "Maxim" for coffee and the Patent Office granted the application on September 21, 1964.

Ender contends that three declarations in General Foods' application were false: that the trademark "was first used [by General Foods] in interstate commerce on November 29, 1963;" "that to the best of [General Foods'] knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce . . . ;" and that General Foods "believe[d] . . . [General Foods] to be the owner of the mark sought to be registered . . . ."

In the fall of 1965, Ender for the first time began marketing canned fruit juices under the name "Maxim." General Foods advised Ender that the sale of juices under the name "Maxim" was a violation of the consent agreement, but

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Ender maintained that fruit juices were not "beverage[s]" or "beverage product[s]" within the meaning of that agreement. The parties were unable to reach an accord, and in May, 1967 General Foods commenced an action against Ender in the Supreme Court of New York seeking an injunction against Ender's continued use of the name "Maxim" in connection with the sale of juices. General Foods' complaint set forth two causes of action. The first alleged that Ender had breached its contractual obligations under the consent agreement. The second alleged that Ender's "deliberate use, intended to create confusion, of the name 'Maxim' for orange juice and other beverages infringes [General Foods'] use of the name, and constitutes an unlawful and unfair trade practice . . . [in] violat[ion of] Section 368-d of the [New York] General business law." While General Foods alleged that it had procured registration of the mark "Maxim" for coffee, General Foods clearly based its request for injunctive relief on the theory that Ender's use of "Maxim" constituted unfair competition.

On July 16, 1970, before any decision had been rendered in the state court action, Ender commenced this action in the district court seeking damages and cancellation of General Foods' "Maxim" registration on the ground that General Foods' application was false in the particulars set forth above. The damages Ender claimed to have "sustained in consequence" of General Foods' procurement of the registration on the basis of false statements were the expenses of defending the state court action that General Foods had commenced. General Foods moved to dismiss the complaint for lack of subject matter jurisdiction and for failure to state a claim upon which relief could be granted, and Ender cross-moved for summary judgment. The district court denied Ender's motion for summary judgment, denied General Foods' motion to dismiss "without prejudice to its renewal at a more appropriate time,"

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and, because the state court action was sub judice, stayed all proceedings in the federal action pending decision in the state court proceeding. But compare *Kline* v. *Burke Construction Co.*, 260 U.S. 226, 230-32 (1922); *Friedman* v. *N.B.C. Motorcycle Imports, Inc.*, 452 F.2d 1215, 1217 (2d Cir. 1971); *Vernitron Corp.* v. *Benjamin*, 440 F.2d 105 (2d Cir.), cert. denied, 420 U.S. 987 (1971).

In May, 1971 the state court rendered its decision, granting General Foods' application for a permanent injunction against Ender's continued use of "Maxim" in connection with the sale of juices. Ender unsuccessfully appealed that judgment, and General Foods then renewed its motion in the district court for dismissal of the complaint, and moved for summary judgment on the grounds of collateral estoppel. Ender amended its complaint to allege that General Foods had falsely declared in its application for registration that it had used the trademark in interstate commerce on November 29, 1963 "whereas in truth and in fact [General Foods] did not commence such use in [interstate] commerce until the month of May, 1964." In addition, Ender purported to set forth a new claim for relief based on 28 U.S.C. §§1331(a), 1343(3) (1970), alleging that the circumstances under which Ender's motion for a new trial in the New York courts was denied constituted a deprivation of due process and equal protection in violation of the fifth and fourteenth amendments, and requesting the district court to declare the judgment of the New York court "in all respects null and void, and that any orders, judgments and proceedings based thereon are also in all respects null and void . . . ." The district court granted General Foods' motion for summary judgment on the ground of collateral estoppel holding that "[t]he issues upon which Ender's claim is asserted here were finally and conclusively determined adversely to Ender" in the New York state court. As to Ender's §§1331 and 1343 claims

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for relief based on the denial of a new trial, the district court ruled that there were no "discernible constitutional questions posed by this contention."

II.

The district court held, and General Foods contends on this appeal, that the factual determination by the state court that General Foods did not fraudulently obtain registration of its "Maxim" trademark collaterally estops Ender from asserting in this action, based on §1120, that General Foods' trademark application was fraudulent and that the trademark registration is invalid. An examination of the complaint and the decision in the state court action leads us to conclude, however, that the factual issues litigated in that action are not conclusive as to the factual issues Ender sought to litigate in this action.

General Foods premised the "second cause of action" in the state court suit on New York General Business Law §368-d (McKinney 1968). That section provides:

> "Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition. . . ."

The opinion in the state court action clearly demonstrates that the decision in favor of General Foods was based on the theory that Ender's conduct in labeling the canned juices with the name "Maxim" constituted unfair competition. Ender had raised the issue of the allegedly false declarations in the application by way of the equitable defense of "unclean hands." While the state court did write that Ender's "claim of fraudulent conduct of [General Foods] in connection with its filing of its application

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for registration of the trademark *Maxim* for coffee is without merit," it explicitly stated that such a factual finding was totally "irrelevant to the issues here presented, because [General Foods'] causes of action do not depend on its registration of the name *Maxim* for coffee." Since General Foods had a cause of action for unfair competition under §368-d regardless of whether or not a trademark had been registered with the Patent Office, the state court was not required to pass upon the question of either the validity of General Foods' trademark or the truth or falsity of the declarations in the application for registration. The state court said:

> "As to the second cause of action for unfair trade practices, Section 368-d of the General Business Law explicitly provides that the remedies of the section are available to protect a trademark 'registered or not registered.' The irrelevance of the assertion of fraudulent conduct with respect to [General Foods'] application for registration is, in our opinion, dispositive of [Ender's] contention, so far as the issues presented in this action are concerned.
>
> "The merit or lack of merit or baselessness of [Ender's] claim may properly be left for determination in an appropriate action or proceeding in a proper forum, since the irrelevant claim does not bar [General Foods'] relief in the instant action."

The state court's "factual finding" as to the fraud was "not material" to its decision, *Partmar Corp.* v. *Paramount Pictures Theatres Corp.*, 347 U.S. 89, 100 (1954), and success in the state action was not dependent upon General Foods' establishing the validity of the registration of its trademark. Therefore the questions of the validity of General Foods' trademark and the truth or falsity of the

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declarations in the application were not necessarily litigated and determined in the original [state court] action. See *Cromwell* v. *County of Sac*, 94 U.S. 351, 353 (1877); *Baltimore S.S. Co.* v. *Phillips*, 274 U.S. 316, 319 (1927). Thus the district court's grant of General Foods' motion for summary judgment on the grounds of collateral estoppel was erroneous.

But the same analysis that leads to the conclusion that it would be inappropriate to apply the doctrine of collateral estoppel in this action also establishes that the damages Ender alleged were not "sustained in consequence" of General Foods' procurement of trademark registration as a result of the allegedly false declarations in the application. The monetary damages Ender alleged that it had suffered as a result of General Foods' "illegal" procurement of registration for "Maxim" were the expenses of defending the state court action. But it was totally irrelevant to that action whether or not General Foods' trademark was registered, since General Foods prevailed on the merits on a theory of unfair competition. Ender's expenses of defending an action in which the fact of registration was totally irrelevant did not therefore result from General Foods' allegedly invalid procurement of federal registration. The cases cited by Ender to support the proposition that the expenses of defending the state court action are recoverable in an action based on §1120 are inapposite.

We hold, therefore, that since General Foods' state court action was not predicated upon the federal registration of its "Maxim" trademark for coffee, Ender has failed to allege any damage "sustained in consequence" of the alleged false declarations in the application for registration. The district court should, therefore, have granted appellee's motion to dismiss for failure to state a claim upon which relief could be granted.

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III.

In the district court, Ender amended its complaint to allege that the circumstances under which its motion for a new trial was denied by the state court constituted a denial of due process and equal protection of the laws in violation of the fifth and fourteenth amendments. After the state trial judge had rendered decision in that case, Ender moved for a new trial on the grounds of newly discovered evidence, which, Ender maintained, showed that General Foods would not have suffered irreparable injury if Ender continued to label its canned juices "Maxim." Before the trial judge had ruled on this motion he was killed in an automobile accident. Under New York procedure, C.P.L.R. §9002, the administrative justice refused to entertain the motion for a new trial on the ground that he had no power under C.P.L.R. §5015 to do so. Under New York procedure, the trial justice may entertain a motion to set aside his decision on the ground of newly discovered evidence if such a motion is made within fifteen days of his decision, C.P.L.R. §§4404, 4405 and, under C.P.L.R. §5015 (a)(2), "the court" can take the same action if the evidence "could not have been discovered in time for a new trial under section 4404." Ender maintains that the statutory scheme as interpreted deprived Ender of due process and equal protection because the trial judge died before ruling on the merits of the §4404 motion, and Ender could not move under §5015 because a timely §4404 motion had been made.

Ender's attempt to assert these constitutional claims suffers from fatal defects. First, Ender alleged that the district court had jurisdiction to decide these claims under 28 U.S.C. §§1331, 1343(3) (1970). We fail to perceive how General Foods could be considered the proper defendant in such actions, since Ender does not argue that *General*

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Foods' conduct "damaged" Ender or deprived it of any federal rights under color of state law. Second, Ender apparently was asking the district court to declare the state court judgment void so as to avoid any collateral estoppel effect that judgment might have in this action. We need not even discuss the obvious question of whether a federal district court has the power to grant the relief requested by Ender in these circumstances. See *Atlantic Coast Line R.R.* v. *Brotherhood of Locomotive Engineers*, 398 U.S. 281, 296 (1970). It is sufficient to point out that since we hold that the judgment of the state court could not estop Ender from litigating the factual issues it sought to litigate in this action, the constitutional issues Ender attempts to raise are wholly immaterial.

Third, and most important, the very constitutional issues that Ender sought to assert are considered to have been conclusively decided against Ender by the state courts. Ender appealed both the judgment and the order denying the motion to set aside the trial court's decision or for a new trial to the Appellate Division, which affirmed both. The record does not clearly disclose whether Ender actually presented the constitutional claims to the Appellate Division, but it did advance these arguments in applying for leave to appeal to the New York Court of Appeals. That motion was denied by Chief Judge Fuld, and Ender thereupon sought relief by amending its complaint in the instant action.

The issue of the constitutionality of the C.P.L.R. provisions, as interpreted, was part of the entire case presented to the Appellate Division, and was also presented to the Court of Appeals. *New York ex rel. Bryant* v. *Zimmerman*, 278 U.S. 63, 67 (1928); *McGoldrick* v. *Compagnie Generale Transatlantique*, 309 U.S. 430, 434 (1940); *Street* v. *New York*, 394 U.S. 576, 583-84 (1969). The proper procedure for Ender to follow in order to vindicate what

it asserts to be its constitutional rights was to appeal the decision of the state courts to the Supreme Court. Absent such an appeal, the constitutional issues were conclusively determined against Ender, *Rooker* v. *Fidelity Trust Co.*, 263 U.S. 413 (1923); *Angel* v. *Bullington*, 330 U.S. 183, 186-87 (1947).

Affirmed.

KAUFMAN, *Circuit Judge* (concurring):

I concur in Parts I and II of Judge Hays' opinion, affirming summary judgment against Ender on its claims under 15 U.S.C. §1120. Although I agree with the result reached in Part III, which affirms summary judgment against Ender on its constitutional claims, I am unable to concur in the third ground advanced to support that result. Judge Hays holds, as I read his opinion, that Ender's constitutional claims of denial of due process and equal protection of the law were presented to the New York courts and Ender's only recourse from an adverse decision was an appeal to the Supreme Court. I do not believe, however, that raising the constitutional issues in an application to the New York Court of Appeals for leave to appeal can be considered a sufficiently full litigation of these claims to bar Ender from raising them *de novo* in a federal court.[1] *Compare England* v. *Louisiana State Board of Medical Examiners*, 375 U.S. 411 (1964). Instead, I would reach the merits of these claims and would hold that Ender was not deprived of any constitutional rights.[2] The death of the trial judge before

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1 Judge Hays notes that "The record does not clearly disclose whether Ender actually presented the constitutional claims to the Appellate Division . . . ."

2 I realize there is a deceptive similarity between Judge Hays' position and my own. The distinction becomes immediately apparent if we assume *arguendo* that Ender had been deprived of constitutional rights by the

acting on Ender's post trial motion did not *ipso facto* entitle Ender to a new trial. His claim that under New York law he was entitled to a new trial or to have the trial court's decision set aside on the ground of newly discovered evidence was presented to the Appellate Division and the Court of Appeals and, we must assume, considered by both courts. Accordingly, I fail to see how the procedures employed by the New York courts in these circumstances deprived Ender of due process or equal protection of the law.

OAKES, *Circuit Judge* (concurring):

I concur in Judge Hay's opinion but in reference to Part III thereof do so only on the first ground advanced, viz., that under no construction of the facts can it be claimed that General Foods' conduct damaged Ender or deprived it of any fourteenth amendment rights under color of state law. Parenthetically it may be remarked that Ender would have had no standing to raise fourteenth amendment questions under the long-rejected views expressed in Mr. Justice Black's famous dissent in *Connecticut General Life Insurance Co.* v. *Johnson*, 303 U.S. 77, 87 (1938), and later in Mr. Justice Douglas's dissent in *Wheeling Steel Corp.* v. *Glander*, 337 U.S. 562, 576 (1949) (Black, *J.*, joining). *But cf. NAACP* v. *Button*, 371 U.S. 415, 428 (1963) (corporation "directly engaged in" protected activities can raise constitutional claims). I know of nothing in the legislative history of the Civil Rights Act that compels us to hold that a corporation is a "person" entitled to protection

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New York courts. As I read Judge Hays' opinion, in that instance he would have affirmed summary judgment because the constitutional claims were not properly before us while I would have reached the merits and reversed the summary judgment, assuming, of course, Ender's action against General Foods was an otherwise proper vehicle for presenting these constitutional claims.

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thereunder irrespective of the activity engaged in by it. 28 U.S.C. §§1331, 1343(3) (1970). *See Mickey* v. *Kansas City*, 43 F. Supp. 739, 741 (W.D. Mo. 1942) (religious organization challenging municipal ordinances claimed to interfere with first amendment rights can assert §1343 jurisdiction). *But see Northwestern Fertilizing Co.* v. *Hyde Park*, 18 F. Cas. 393 (No. 10,336) (C.C. N.D. Ill. 1873). In any event it does not seem to me that in a case involving two corporations engaged in ordinary business activity and litigation resulting therefrom we should lean over backward to find conduct by one against the other to constitute "deprivation, under color of any State law . . . ." 28 U.S.C. §1343(3). I find none here.

. . . .

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APPENDIX C

AMENDED COMPLAINT

[Same Title]

The plaintiff, by SIDNEY S. BOBBE, its attorney, for its amended complaint herein, alleges as follows:

FOR A FIRST CAUSE OF ACTION:

FIRST: The plaintiff is a domestic corporation, with its principal place of business at 395 Johnson Avenue, Borough of Brooklyn, City of New York.

SECOND: The defendant is a corporation duly organized and existing under the laws of the State of Delaware, and duly authorized to do business in the State of New York, with its principal place of business at White Plains in the County of Westchester, State of New York.

THIRD: That the jurisdiction of this Court, as it applies to this cause of action, is based upon the Trademark Act of 1946, as amended (15 U.S.C. 1051 *et seq;* and particularly 1121).

FOURTH: Plaintiff is the owner by assignment of a trademark consisting of the name "Maxim" for sardines, registered in Class 46, Foods and Ingredients of Foods, on October 20, 1908, under Number 70,961; and said registration is still in full force and effect, having been renewed from time to time.

FIFTH: That on or about the 31st day of July, 1963,

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plaintiff entered into a contract with one Forgacs, wherein among other things the plaintiff was acknowledged to be the owner of said trademark, and wherein it gave its consent to the use by said Forgacs or his assignees of said trademark, limited, however, to coffee or tea in any form.

SIXTH: That said Forgacs entered into said contract as the undisclosed agent of the defendant herein, and, as plaintiff is informed and believes, said contract was thereafter assigned by Forgacs to the defendant.

SEVENTH: That in order to induce the plaintiff to give such limited consent to the use by it of the name "Maxim", defendant, by its agent aforesaid, warranted and represented to the plaintiff that it was not interested in purchasing said trademark outright, but only wanted to acquire its use limited as aforesaid, since it understood that plaintiff intended to preserve and expand its own use of the mark except to the extent of the consent it had given for the limited use thereof by the defendant.

EIGHTH: That after the assignment of said contract to the defendant, and on or about the 21st day of January, 1964, defendant filed an application with the United States Patent Office for the registration of the trademark "Maxim" for coffee on the Principal Register of said patent office, without revealing to the Commissioner of Patents, however, the fact that it had obtained from the plaintiff herein the aforesaid limited consent, and without limiting its application to registration for such limited use.

NINTH: In order to procure said registration, said application falsely and fraudulently represented that said

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trademark had first been used in interstate commerce on November 29, 1963, by the defendant, and that at the time of the application it was in use by defendant in such commerce, whereas in truth and in fact defendant did not commence such use in said commerce until the month of May, 1964.

TENTH: That as a prerequisite to the procurement of said registration, defendant was required to submit with its application an affidavit by one of its officers, asserting that it believed itself to be the true owner of said trademark which it sought to register, and that to the best of its knowledge and belief, no other person, firm, corporation or association had the right to use said mark in commerce, either in identical form or in such near resemblance thereto as would be likely, when applied to the goods of such other person, to cause confusion or to cause mistake or to deceive; and that the facts set forth in said affidavit were true.

ELEVENTH: That defendant did in fact present such application and such affidavit, a copy of which is annexed hereto as Exhibit A, well knowing that the statements contained therein were false and fraudulent; that it, the defendant, was not the owner of said trademark; and that plaintiff had the right to use said mark in commerce in the identical form, except for the limited use thereof that plaintiff had given to the defendant's assignor.

TWELFTH: That in reliance upon said application and affidavit, the Commissioner of Patents granted to the defendant registration of said trademark "Maxim" for coffee on September 1, 1964.

THIRTEENTH: That subsequent to said fraudulent

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procurement of said registration, and in the month of May, 1967, defendant commenced an action in the Supreme Court of the State of New York, County of Westchester, against the plaintiff herein, falsely claiming that it, the defendant, was the owner of said trademark, and that plaintiff's use thereof on food products such as fruit and vegetable juices constituted an unlawful and unfair trade practice, likely to injure defendant's business reputation and to dilute its use of the name and the distinctive quality of the trademark thus registered by it; and that such injury and the alleged dilution of the trademark constituted grounds for injunctive relief in cases of infringement of a trademark.

FOURTEENTH: That action came on for trial before Mr. Justice John H. Galloway, Jr., who after trial rendered a decision awarding a permanent injunction to the defendant herein, as plaintiff therein; which decision was based in part on a finding that the use by the plaintiff herein of its registered trademark on fruit juices and tomato juice constituted unfair trade practice, in violation of Section 368-d of the New York General Business Law, in that such use of said trademark by the plaintiff herein on canned fruit juices and canned tomato juice engendered a likelihood of injury to the business reputation of the defendant herein, and of dilution of the distinctive quality of the latter's trademark; that such likelihood of injury lay in the fact that the plaintiff herein was selling *canned* juices, whereas the message of the defendant herein, conveyed to the purchasing public, was that its "Maxim" coffee was superior to ordinary instant coffee, and was very similar to freshly-percolated coffee, because of the development of the freeze-drying process, while the canned juice products of the plaintiff herein, merely because they were canned, had a canned flavor, which was likely to injure the reputation of the

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defendant herein.

FIFTEENTH: That before entering a judgment based on said decision, the said Trial Justice died as a result of an accident. A motion had been made before him meanwhile for a new trial on the ground of newly-discovered evidence to the effect that the defendant herein had reversed its claim as to the superiority of its "Maxim" freeze-dried coffee over ordinary instant coffees, by claiming that its own Maxwell House instant coffee was superior to "the highest-priced freeze-dried" – meaning "Maxim". After the Trial Justice's untimely death, the motion was renewed before the Administrative Justice of said Court, who denied it on the ground that only the Trial Justice could pass upon the motion; that he himself lacked the power to do so; and an order to that effect was signed by him simultaneously with his signing the aforementioned judgment.

SIXTEENTH: That said judgment enjoined the defendant therein (the plaintiff herein) permanently from the sale of any "Maxim" canned fruit juices or "Maxim" canned tomato juice, on the ground of breach of contract and of violation of Section 368-d of the General Business Law; and it awarded costs to the plaintiff therein (the defendant herein).

SEVENTEENTH: That the plaintiff herein took a timely appeal from said judgment to the Appellate Division of the Supreme Court, Second Department, which Court affirmed said judgment and order. A subsequent application was made to the Court of Appeals for leave to appeal to it from that disposition, which application was denied.

EIGHTEENTH: That the plaintiff herein was obliged to defend said action and take said appeals at great trouble and

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expense, including attorney's fees and disbursements and printing expenses; and the defendant herein (the plaintiff in that action) has taxed costs against the plaintiff herein which at the present time aggregate more than $9,000. Also, as a result of said injunction, the plaintiff herein has been forced to dispose of large quantities of canned fruit juices and tomato juice, at a great sacrifice, and has been, and will continue to be, deprived of the continued sale of said commodities.

NINETEENTH: That by reason of the foregoing the plaintiff herein has been greatly damaged, due at least in part to the said fraudulent registration by the defendant herein of the trademark "Maxim" for coffee, which could not have been procured by the defendant herein had it disclosed the true facts, and had it not made the fraudulent representations aforesaid.

FOR A SECOND CAUSE OF ACTION:

TWENTIETH: Plaintiff repeats, with the same force and effect as if set forth herein at length, the allegations contained in the first cause of action.

TWENTY-FIRST: That the amount in controversy is in excess of $10,000., exclusive of interest and costs, and the jurisdiction of this Court, as far as it applies to this cause of action, is based on the provisions of 28 U.S.C. Section 1331(a) and 28 U.S.C. Section 1343(3).

TWENTY-SECOND: That the aforementioned decision of Hon. John H. Galloway Jr. in said action brought in the Supreme Court, Westchester County, was rendered on March 5, 1971. On March 16, 1971, the plaintiff herein made its timely motion before said Trial Justice for a new trial on the ground of

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newly-discovered evidence. That evidence had arisen since the trial, and showed that the defendant herein had reversed its claim as to the superiority of its freeze-dried "Maxim" coffee over any ordinary instant coffee, thereby destroying its claim of potential injury to its reputation due to the alleged wrongful use by the plaintiff herein of the trademark as applied to canned juices.

TWENTY-THIRD: That while said motion was under advisement by said Trial Justice, he met with sudden death, and thereupon the plaintiff herein renewed its motion before the Administrative Justice of that Court, who denied it without a hearing, and without considering the merits, on the ground that only the Trial Justice could grant such a motion; that he himself was without power to do so.

TWENTY-FOURTH: That said Administrative Justice thereupon signed the judgment based upon the decision of the Trial Justice, and the order denying the motion.

TWENTY-FIFTH: That the plaintiff herein took a timely appeal from said judgment and said order, both of which were affirmed by the Appellate Division, Second Department, without opinion, and without granting a hearing on the application for a new trial.

TWENTY-SIXTH: That the right of a defeated party in litigation to be heard upon an application for a new trial on the ground of newly-discovered evidence is a well-established and well-recognized right in the State of New York, and one that is granted to every defeated litigant if timely asserted as above.

TWENTY-SEVENTH: That denying the plaintiff herein a

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hearing on said application, because the Trial Justice had died before passing on the application, was a deprivation of plaintiff's civil rights, of its right to due process of law, and of its right to the equal protection of the laws, all in violation of the Fifth Amendment of the constitution of the United States, which provides that

> "No person shall be deprived of life, liberty or property without due process of law"

also in violation of the Fourteenth Amendment, which provides

> "***nor shall any State deprive any person of life, liberty or property without due process of law, nor deny to any person within its jurisdiction the equal protection of the law."

TWENTY-EIGHTH: That the refusal of the Courts of the State of New York to consider plaintiff's application for a new trial on the merits, merely because of the accidental death of the Trial Justice, constitutes a deprivation of plaintiff's property and its liberty to conduct its business without unreasonable interference, and was done without due process of law; also denying plaintiff the equal protection of the law in the right to be heard on its application for a new trial, without any fault on plaintiff's part, and without logical or reasonable justification.

WHEREFORE plaintiff demands judgment:

A. As to the First Cause of Action, canceling the registration of the trademark "Maxim" procured by the defendant, and awarding to the plaintiff the profits derived

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therefrom, as well as the damages sustained by the plaintiff, together with the costs of this action, including a reasonable counsel fee; also directing that the defendant be required to destroy all labels, signs, printed packages and advertising material in its possession bearing such registered trademark, and any reproduction or copy thereof, with all means of making the same;

B. As to the Second Cause of Action, declaring the said judgment entered in the Supreme Court, Westchester County, on the 28th day of May, 1971, to be in violation of the Fifth and Fourteenth amendments of the Constitution of the United States, and in all respects null and void, and that any orders, judgments and proceedings based thereon are also in all respects null and void;

C. That plaintiff be awarded the costs and disbursements of this action, and such other or further relief as to the Court may seem just.

s/Sidney S. Bobbe
Attorney for Plaintiff,
36 West 44th Street New York,
N.Y. 10036 Tel.: MU 2-7218.

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Exhibit A – Application

IN THE UNITED STATES PATENT OFFICE
APPLICATION FOR TRADEMARK REGISTRATION

Mark: MAXIM

Class: 46

TO THE COMMISSIONER OF PATENTS:

GENERAL FOODS CORPORATION, a Delaware corporation having an office at 250 North Street, White Plains, New York (statutory address: 129 South State Street, Dover, Delaware) has adopted and is using the trademark shown in the accompanying drawing for COFFEE and requests that said mark be registered in the United States Patent Office on the Principal Register established by the Act of July 5, 1946.

The trademark was first used on November 29, 1963; was first used in interstate commerce on November 29, 1963; and is now in use in such commerce. The mark is used by applying it to labels affixed to the containers for the goods and five specimen containers showing the mark as actually used are presented herewith.

Please recognize J. SPENCER DALY, a member of the Bar of the State of New York, with office at 250 North Street, White Plains, New York, to prosecute this application, to transact all business in connection therewith and to receive the certificate.

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STATE OF NEW YORK

ss.

COUNTY OF WESTCHESTER

EDWIN W. EBEL, being sworn, states that he is a vice-president of application corporation and is authorized to execute this affidavit on behalf of said corporation; that he believes said corporation to be the owner of the mark sought to be registered; that to the best of his knowledge and belief no other person, firm, corporation or association has the right to the said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake or to deceive; and the facts set forth in this application are true.

/s/ EDWIN W. EBEL JSD
Vice-President 1/14/64

Subscribed and sworn to before
me this 20th day of January 1964.

HELEN GOULD
Notary Public, State of New York
No. 49-1521930 Qual. in Westchester Co.
Certificate held in New York County
Commission Expires March 30, 1965

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APPENDIX D

Provisions of New York's Civil Practice Laws and Rules: (Book 7B, McKinney's Consol. Laws of N.Y.):

"R. 4404 – *Post-trial motion for judgment and new trial:*

(b) Motion after trial where jury not required. After a trial not triable by a jury, upon the motion of any party or on its own initiative, the court may set aside its decision on any judgment entered thereon***.

R.4405 – *Time and judge before whom post-trial motion made:*

A motion under this article shall be made before the judge who presided at the trial within fifteen days after decision, verdict or discharge of the jury***

R. 5015. *Relief from judgment or order:*

(a) On motion, the court which rendered a judgment or order may relieve a party from it upon such terms as may be just, on motion of any interested person with such notice as the court may direct, upon the ground of:***

(2) newly-discovered evidence which, if introduced at the trial, would probably have produced a different result and which could not have been discovered in time to move for a new trial under section 4404;***

R. 9002. *Death, disability or incapacity of judge following verdict, report or decision.*

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The death, sickness, resignation, removal from or expiration of office or other disability or legal incapacity of a judge following his verdict, report or decision upon any matter in a civil judicial proceeding shall not affect its validity. Any other judge of the same court may, on the application of a party, give effect to such verdict, report or decision and make and sign an appropriate order or judgment based thereon, which shall have the same effect as if it had been made by the judge upon whose verdict, report or decision it is based."